



Docket No. 12969

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bitler

Group Art Unit: 1714

Serial No.: 09/398,377

Examiner: Szekely, P.

5 Filing Date: 09/17/99

Title: Polymeric Thickeners for Oil-Containing Compositions

Mail Stop AF

Attention Petitions Branch

Commissioner for Patents, P.O. Box 1450

10 Alexandria, VA 22313-1450

PETITION

Sir,

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This is a petition to the Commissioner

(1) to direct the Examiner to withdraw the finality of the Office Action mailed October 10, 2003, on the ground that a clear issue for appeal has not been developed, and

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(2) insofar as the Commissioner deems it appropriate, to direct the Examiner to provide reasoned answers to the Applicants' arguments.

Similarity of the Issues raised in this Petition and the Issues raised in the Petition filed December 11, 2003, on the continuation-in-part application Serial 09/810,920

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The issues raised by this petition are substantially the same as the issues raised in the Petition filed December 11, 2003, on the continuation-in-part application Serial 09/810,920.

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

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On March 5, 2004 Typed name of person signing this certificate: T. H. P. Richardson

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Background

On June 17, 2003, Applicants mailed a petition asking the Commissioner to direct the Examiner as to the correct construction of certain claims of this application.

5 No decision has yet issued on that petition. However, the issues raised by the Petition mailed June 17, 2003, are substantially the same as the issues raised on a similar petition, also mailed June 17, 2003, on the continuation-in-part application, Serial No. 09/810,920. The Decision on that similar petition (i.e. the Petition mailed June 17, 2003, on the continuation-in-part application) dismissed that petition because there was
10 no issue ripe for petition, there being at that time no final rejection, and because, although it is desirable that any appeal should be based on an agreed construction of the claims, that issue did not appear to be a petitionable matter. The decision also stated

*Before making the next office action final, the Examiner should clearly point out
15 how he is interpreting the claims and provide clear reasoning as to why he is interpreting the claims in that manner. Applicant's arguments regarding this matter should be thoroughly addressed.*

Upon receipt of a final office action, if Petitioner feels that a clear issue for appeal has not been developed, a petition to withdraw the finality can be filed.

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Although no decision has issued on the Petition mailed June 17, 2003, on this case, the Examiner has now made a final rejection in this case. As noted in detail below, Applicant believes that the finality of the present final rejection should be withdrawn because the Examiner has failed to "clearly point out how he is interpreting
25 the claims and provide clear reasoning as to why he is interpreting the claims in that manner", and has failed to "thoroughly address" the Applicant's arguments.

The Issues

30 The issues which are not clear are
(1) the construction of the claims,

(2) the rejection of claims under 35 USC 102, and
(3) the rejection of the claims under 35 USC 103,
each of which is discussed below.

5 1. The Construction of the Claims

For the reasons explained below, the correct construction of the claims is important to clarification of the rejections under 35 USC 102 and 103. [For the avoidance of doubt, it is noted, however, that the construction of the claims is not the
10 only issue which Applicant asks the Commissioner to consider in connection with the rejections under 35 USC 102 and 103.] Under these circumstances, the Commissioner is asked to reconsider the earlier decision stating that the construction of the claims "does not appear to be a petitionable matter".

15 In the final Office Action, the Examiner makes the following statement with regard to the construction of claims.

*Morawsky et al.... does contain the phrase "present in the amount sufficient to thicken the composition"... so that limitation is not new matter... Since Morawsky et al. define that amount as 0.1-12% by weight based on the oil, the phrase will
20 be interpreted as such. Applicants do not agree with the Examiner about Morawsky et al. limiting the useful concentration range of the thickener to the above range. It is their privilege. However this disagreement is completely inconsequential as far as the instant rejection is concerned.*

Thus, the Examiner has not "thoroughly addressed" the reasons set out in the
25 previously filed Petition, in particular in paragraphs A-D on pages 8-9 thereof, in support of Applicants' argument that the Examiner's construction of the claims is wrong. [The Examiner was specifically requested to consider the arguments in the Petition, and to forward the petition to the Petitions Branch only if he was not prepared to agree with the Applicants' construction of claims -- see page 3 of the Reply mailed June 17, 2003.]
30 Rather, the Examiner has simply asserted that the disagreement as to the construction of the claims "is completely inconsequential so far as the instant rejection is concerned".

The Final Office Action then continues: --

Morawsky et al. prove that the 0.1-12% by weight based on the oil concentration range is synonymous to or within the claimed concentration range which thickens the oil. Therefore, said concentration range overlaps the 0.001-1% by weight based on the oil concentration range disclosed by Mueller et al 5,281,329, and thus applicants' claims are not novel or non-obvious over the disclosures of the cited references.

Applicants are not entirely confident that they have completely understood this passage.

However, it appears that the Examiner is saying that because there is an overlap between

(i) the broadest numerical range explicitly disclosed in Morawsky et al. (0.1-12%) for the amount of certain specifically defined carboxyl-containing side chain crystalline (SCC) polymer to be used to thicken oils, and

(ii) the broadest numerical range explicitly disclosed in Mueller et al. (0.001-1%) for the amount of certain specifically defined SCC polymers (which do **not** contain the carboxyl groups essential to Morawsky et al.) to be used in order to depress the pour point of certain oils (which necessarily means that the effect of the SCC polymer is to make the oil thinner, **not** to make the oil thicker),

it necessarily follows that the rejected claims are not novel.

Thus, it appears that the Examiner is not only saying that the rejected claims are limited to amounts of the additive in the range 0.1-12%, but is also saying that the stated requirement that the additive thickens the oil should be ignored. This is the only possible explanation for the Examiner's rejection of the claims under 35 USC 102 over Mueller et al, in which the additive is used in an amount which makes the oil thinner, not thicker. [At one time during prosecution, the Examiner appeared to think that use of an additive as a pour point depressant for an oil was synonymous with thickening the oil. In fact, the reverse is true. There can be no doubt that Mueller's additive, when used in accordance with Mueller's instructions, functions as a thinner in the temperature range between (i) the pour point of the oil and (ii) the pour point of the mixture of oil and

additive--nor is there any reason to suppose that the same is not true at higher temperatures.]

Applicants believe, therefore, that the correct construction of claims, so far from being "completely inconsequential", is fundamental to the rejections, which must be withdrawn if the claims are correctly construed. Even if the Commissioner continues to think that the proper construction of claims is not a matter that can be dealt with by way of petition, Applicants suggest that the Commissioner should direct the Examiner to formulate his rejections in alternative forms, one form directed to the construction that the Examiner believes to be correct and the other form directed to the construction that Applicants believe to be correct. There will otherwise be a danger that, if the Examiner's construction is found to be wrong (no doubt after a lengthy appeal process), prosecution will have to resume, based on a new construction of claims.

2. The rejection of the claims under 35 USC 102

(a) A number of the claims have been rejected under 35 USC 102 "as being anticipated by Mueller et al 5,281,329, with Morawsky et al. 5,736 125 as a teaching reference". The claims were likewise rejected in the previous Office Action on this ground, and as out in detail on page 23, line 6-10, of the Reply mailed June 17, 2003, Applicants argued that such a rejection was improper because a rejection under 35 USC 102 must be based on a single reference. The Examiner has made no comment on the argument.

(b) As set out in detail on pages 18-20 of the Reply mailed June 17, 2003, Applicants argued that the rejection under 35 USC 102 should be withdrawn because (1) the claims require that the SCC polymer is present in an amount such that it thickens the oil, and (2) the claims are directed to cosmetic compositions. As noted above, it appears that the Examiner, because he has adopted an incorrect construction of the claims, thinks that the first of these differences is unimportant; in any event he has made no comment on Applicants' arguments beyond that set out above. As to the fact

that the claims are directed to cosmetic compositions, the Final Office Action contains no rebuttal argument at all.

3. The rejection of the claims under 35 USC 103

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(a) A number of the claims have been rejected under 35 USC 103 over Mueller et al 5,281,329 in view of Morawsky et al. 5,736,125. The claims were likewise rejected in the previous Office Action on this ground, and as out in detail on page 20 of the Reply mailed June 17, 2003, Applicants argued that such a rejection was improper because
10 there was no reason to read these references together. The Final Rejection contains no comment on this argument.

(b) Applicants also argued, on page 21-23 of the Reply mailed June 17, 2003, that even if the references could properly be combined, they did not disclose or suggest the
15 claimed invention. For example, Applicants noted that

(i) the SCC polymers used by Mueller and Morawsky are different, and there is nothing to suggest that the SCC polymers used by Mueller are interchangeable with the SCC polymers used by Morawsky;

(ii) Mueller's objective is to lower the pour point of an oil, which necessarily
20 means that the oil is made thinner, whereas Morawsky's objective is to thicken an oil;

(iii) Mueller discloses a preferred range of 0.005 to 0.2% for the concentration of additive, and in fact uses, in the specific Examples, 0.04 to 0.1%; and Morawsky discloses a preferred range of 0.5 to 10%, and in fact uses, in the
25 specific Examples 5%., so that there is no overlap between the concentration ranges in which Mueller and Morawsky achieved practical results.

Respectfully submitted,



T. H. P. Richardson

Registration No.28,805, Tel No. 650 854 630

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